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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/047,147	01/14/2002	Antony P. Chacko	CTS-2261	5040
29184	7590	11/03/2003	EXAMINER	
CTS CORPORATION 905 W. BLVD. N ELKHART, IN 46502			SZEKELY, PETER A	
			ART UNIT	PAPER NUMBER

1734

DATE MAILED: 11/03/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.		Applicant(s)	
	10/047,147		CHACKO, ANTONY P.	
	Examiner		Art Unit	
	Peter Szekely		1714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) 15-22 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 1-6 and 8-11 is/are rejected.
- 7) ☒ Claim(s) 7 and 12-14 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 14 January 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ |
| 2) <input checked="" type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) <u>1142</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-14, drawn to a film, classified in class 524, subclass 495.
 - II. Claims 15-22, drawn to a potentiometer, classified in class 338, subclass 160.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as mutually exclusive species in an intermediate-final product relationship. Distinctness is proven for claims in this relationship if the intermediate product is useful to make other than the final product (MPEP § 806.04(b), 3rd paragraph), and the species are patentably distinct (MPEP § 806.04(h)). In the instant case, the intermediate product is deemed to be useful as unsupported packaging film and the inventions are deemed patentably distinct since there is nothing on this record to show them to be obvious variants. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions anticipated by the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

4. During a telephone conversation with Mark Bourgeois on 10/29/03 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-3, 5, 6, 9 and 11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Gardos et al. 5,035,836

7. Gardos et al. disclose graphite, carbon powder and DAP in Example 4, phenolic substrate in Example 2, 0.8 micron particle size graphite in column 4, line 26 and polymers in claim 4. For contact wiper see claim 1. Applicant's claims are not novel. In the alternative choosing the small particle size graphite is desirable because it gives more uniform resistivity and surface finish, reinforcing phenolic resins with fibers is well known and obvious and using a blend of resins from a list of equivalents would be obvious to one having ordinary skill in the art, especially when the base resin is also thermosetting.

8. Claims 1-6 and 8-11 are rejected under 35 U.S.C. 102(b or e) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Utsumi et al. 5,318,823,

Savin 5,677,367, Shaw, Jr. et al. 5,955,936, Babinec et al. 6,380,294 or Mowrey 6,512,039.

9. Since the potentiometer and the movable wiper are part of the preamble only and they are not part of the body of the claims, they represent the intended use and as such they have no patentable significance. See MPEP 2111.02. Utsumi et al. teach a polyester film in claim 1. colloidal silica and carbon black in claim 4 and concentrations in claim 3. Savin recites a blend of epoxy and polyester with graphite in claim 23 and fumed silica in claim 33. See also the Examples. Shaw, Jr. et al. divulges polyolefins in claim 2, carbon black in claim 7 and fumed silica in claim 8. Babinac et al. reveal polymer and carbon black in claim 2 and fumed silica in claim 10. For other polymers see columns 15-20. Mowrey displays applicant's composition in Example 3 and substrates in column 15, lines 25-49. See also Examples C and E. Applicant's claims are not novel. In the alternative, it would have been obvious to one having ordinary skill in the art; at the time the invention was made, to select applicant's ingredients from a list of equivalents. Since the criticality of the concentrations of the individual ingredients have not been elucidated in the specification, the examiner holds that any concentration would have been obvious to one having ordinary skill in the art, at the time the invention was made.

10. Claims 1-6 and 8-11 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Wiley et al. 3,870,987, Bloore et al. 4,313,101, Uchikawa et al. 4,621,249, Smith-Johannsen 5,057,674 or Carlson et al. 5,430,087.

11. Wiley et al. present applicant's composition in Table I. Bloore et al. show polymer and fumed silica in column 3, lines 18-22 and carbon black in claim 1. For particle sizes see claims 7-8. Uchikawa et al. relate applicant's composition in Formulation 7. Smith-Johannsen reports applicant's composition in claim 6, while Carlson et al. describe it in claim 4. Applicant's claims are not novel. The motivation for the obviousness rejection, see paragraph 9.

Specification

12. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The 40-75% cured polymer of claim 2, the 10-35% conductive particles of claim 55, the 1-5% thermosetting resin of claim 4 and the ceramic, FR-4 and fiber reinforced phenolic surfaces of claim 1 cannot be found in the specification. Furthermore DAIP on page 13, last line is an unexplained abbreviation. There cannot be any unexplained abbreviations in the specification.

Claim Rejections - 35 USC § 112

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claim 11 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

15. FR-4 is an unexplained abbreviation. There cannot be any unexplained abbreviations in the claims.

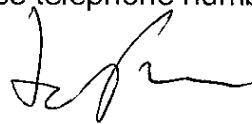
Allowable Subject Matter

16. Claims 7 and 12-14 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

17. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Peter Szekely whose telephone number is (703) 308-2460. The examiner can normally be reached on 7:00 a.m.-5:30 p.m. Tuesday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Vasu Jagannathan can be reached on (703) 306-2777. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Peter Szekely
Primary Examiner
Art Unit 1714

P.S.
10/29/03